

**DECLARATION IN SUPPORT OF REQUEST FOR
RECONSIDERATION/PETITION FOR SUPERVISORY REVIEW OF
DECISION DENYING PETITION FOR A FILING DATE IN
APPLICATION NO. 08/113,955**

I provide this Declaration in support of a Request for Reconsideration/Petition for Supervisory Review of Decision Denying Petition for a Filing Date in Application No. 08/113,955.

I, Jeffrey V. Nase, hereby declare that:

I. INTRODUCTION

1. I have been asked by Encyclopaedia Britannica, Inc., (“Britannica”) to provide my opinion as to whether Application No. 08/113,955 (“the ‘955 application”) is entitled to a filing date of August 31, 1993 and if the ‘955 application can be relied upon for priority under 35 U.S.C. § 120.

II. QUALIFICATIONS

2. I received a B.S. in Mechanical Engineering from Drexel University in 1973. I received a Juris Doctor degree from George Mason University in 1986. I was admitted to the Bar of the Commonwealth of Virginia in 1986.
3. I became a Patent Examiner at the United States Patent and Trademark Office (“USPTO”) in 1973 in the conveying and transportation related technological art area. I received the authority to grant or deny patents over my own signature in 1979.
4. In 1987, I was appointed to supervise the Office of Petitions. In 1993 I held the title of Director of the Office of Petitions and in 1994, this position became the Patent

Legal Administrator in the Office of the Deputy Assistant Commissioner for Patent Policy & Projects. The duties of these positions included: (1) Rulemaking, Official Gazette Notices and Patentability Guidelines; (2) Deciding petitions that came under the authority of the Office of the Deputy Assistant Commissioner for Patent Policy & Projects, including filing date petitions; and (3) Special projects such as conducting briefings on legal topics for visiting officials.

5. In 1996, I was appointed as an Administrative Patent Judge and member of the Board of Patent Appeals and Interferences (“the Board”) in the USPTO. The Board's decisions constitute final agency determinations with respect to substantive questions of patent law. They are reviewable directly by the Federal Circuit or by the United States District Court for the District of Columbia, whose decisions, in turn, are reviewable by the Federal Circuit.
6. In February 2006, I retired from the Board and the USPTO. In June 2006, I became a member of the intellectual property law firm of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. (“the Oblon firm”) in Alexandria, Virginia, specializing in all phases of patent application preparation and prosecution. I left the Oblon firm in early December 2006. From mid December 2006 through the present I have been a consultant to HersHKovitz & Associates, LLC by providing assistance with some of their more complex patent matters such as reexamination, appeals to the Board of Patent Appeals and Interferences and petition practice at the USPTO.
7. During my career, I have been involved in numerous aspects of patent practice, including the determination of the official filing date of an application filed in the USPTO.

III. MATERIALS REVIEWED

8. In forming my opinion and preparing this Declaration, I have reviewed the file histories of the '955 application, Application No. 08/202,985 ("the '985 application") and U.S. Patent No. 5,241,671 and the pertinent sections of Title 35 U.S.C., Title 37 C.F.R. and the Manual of Patent Examining Procedure ("MPEP").
9. As the '955 application was deposited with the USPTO on August 31, 1993, the statutes, rules, and procedures in effect at that time will be relied upon in forming my opinion as to whether the '955 application is entitled to a filing date of August 31, 1993 and if the '955 application can be relied upon for priority under 35 U.S.C. § 120.
10. At the time the '955 application was deposited with the USPTO on August 31, 1993: 35 U.S.C. § 111 stated:

Application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawings are submitted, within such period and under such conditions, including payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is show to the satisfaction of the Commissioner that the delay in submitting the fee and oath was unavoidable. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

35 U.S.C § 120 stated:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an

inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

37 CFR § 1.22(b) stated:

All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent or other proceeding in such a manner that it is clear for which purpose the fees are paid.

37 CFR § 1.53(b) stated:

The filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and (2) any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41. No new matter may be introduced into an application after its filing date (§ 1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in § 1.17(i)(1) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and § 1.78(a)) may be filed pursuant to the section, § 1.60 or 1.62. A continuation-in-part may be filed pursuant to this section or § 1.62.

37 CFR 1.53(d) stated:

If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by applicant, the applicant will be so notified, if a correspondence address has been provide and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in § 1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(1) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of.

37 CFR 1.72(a) stated:

The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application.

37 CFR 1.77 stated:

The elements of the application should appear in the following order.

(a) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention may be used.

(b) (Reserved).

(c)(1) Cross-reference to related applications, if any.

(2) Reference to a "microfiche appendix" if any. (See § 1.96(a)). The total number of microfiche and total number of frames should be specified.

(d) Brief summary of the invention.

(e) Brief description of the several views of the drawing, if there are drawings.

(f) Detailed description.

(g) Claim or claims.

(h) Abstract of the disclosure.

(i) Signed oath or declaration.

(j) Drawings.

37 CFR 1.78(a) stated:

An application may claim an invention disclosed in a prior filed copending national application or international application designating the United States of America. In order for an application to claim the benefit of a prior copending national application, the prior application must name as an inventor at least one inventor named in the later filed application and disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the prior application must be (1) complete as set forth in § 1.51, or (2) entitled to a filing date as set forth in § 1.53(b) and include the basic filing fee set forth in § 1.16; or (3) entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(1) within the time period set forth in § 1.53(d).

Any application claiming the benefit of a prior filed copending national or international application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior application, identifying it by serial number and filing date or international application number and international filing date and indicating the relationship of the application. Cross-references to other related applications may be made when appropriate. (See § 1.14(b).)

MPEP 601.01 stated:

The following forms used by Application Branch to notify applicants of defects are reproduced on the following pages. "Notice to File Missing Parts of Application - Filing Date Granted" form PTO-1533; "Notice to File Missing Parts of Application - No Filing Date"; form PTO-1532, "Notice of Informal Application" form PTO-152; "Notice of Incomplete Application", form PTO-1123, and "Notice of Incomplete Application filed Pursuant to 37 CFR 1.60" form PTO-1534.

The "Notice to File Missing Parts of Application - No Filing Date" (form PTO-1532) is reproduced at page 600-7 of the MPEP. The first paragraph of this form stated:

In order to avoid payment by applicant of the surcharge required if items 1 and 3-6 are filed after the filing date the following items are also brought to applicant's attention at this time.

Following item 8, this form included the following language:

Required items 1-7 above SHOULD be filed, if possible, with any items required on the "Notice of Incomplete Application" enclosed with this form. If concurrent filing of all required items is not possible, items 1-7 above must be filed no later than two months from the filing date of this application. The filing date will be the date of receipt of the items required on the "Notice of Incomplete Application." If items 1 and 3-6 above are submitted after the filing date, THE PAYMENT OF A SURCHARGE OF \$____for large entities, or \$____for small entities who have filed a verified statement claiming such status, is required. (37 CFR 1.16(e)).

Applicant must file all the required items 1-7 indicated above within two months from any filing date granted to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

MPEP 608.01 stated:

Applications filed without all pages of the specification are not given a filing date since they are "prima facie" incomplete. The filing date is the date on which the omitted pages are filed. If the oath or declaration for the application was filed prior to the submission of all pages of specification, the submission of any omitted pages must be accompanied by a supplemental oath or declaration referring to the specification originally deposited, as amended to include the pages originally omitted. If the oath or declaration for the application was not filed prior to the submission of the omitted pages, the oath or declaration when filed, must include a specific reference to pages originally omitted. If any applicant believes that the omitted pages of the application are not necessary for an understanding of

the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support and renumbering the pages present in consecutive order. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support.

IV. BASIS OF OPINION

11. My opinion is based on my personal knowledge and expertise, and my review and investigation of the items and materials described above.

V. OPINION FORMED

12. Application No. 08/113,955 is entitled to a filing date of August 31, 1993 and the '955 application can be relied upon for priority under 35 U.S.C. § 120 and 37 CFR § 1.78(a) for the reasons which follow.

Application Histories

13. On October 26, 1989, Application No. 07/426,917 ("the '917 application") was filed in the USPTO under 37 C.F.R. § 1.53. This application issued as U.S. Patent No. 5,241,671 on August 31, 1993.
14. On August 31, 1993, the '955 application was filed in the USPTO under 37 C.F.R. § 1.53. This application contained a two page cover letter stating that 68 pages of specification (including claims, abstract, etc.) and 20 pages of drawings were being

filed. The USPTO received the two page cover letter, 20 pages of drawings and 68 pages of specification. The 68 pages of specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The unnumbered title page included the following items in addition to the title: a listing of the 14 inventors by name, a docket number and the name and address of the law firm who prepared the application. Page numbered 2 started in mid-sentence. No filing fees were paid and no oath or declaration accompanied the application.

15. On September 14, 1993, the USPTO issued (1) a Notice of Incomplete Application, form PTO-1123; and (2) a Notice to File Missing Parts – No Filing Date, form PTO-1532. The Notice of Incomplete Application provided that no filing date was granted to the ‘955 application since page 1 was missing. The Notice to File Missing Parts – No Filing Date required that the filing fees of \$2,156 be paid and the oath or declaration be filed. However, this Notice to File Missing Parts – No Filing Date was not the version of the form PTO-1532 reproduced in the MPEP at page 600-7. Instead of setting a period to response of two months from any filing date granted to avoid abandonment, this Notice to File Missing Parts – No Filing Date did not set a period for response.

16. On October 29, 1993, the applicants filed a petition under 37 C.F.R. §§ 1.53 and 1.182 requesting the ‘955 application proceed without page 1 and that it be accorded a filing date of August 31, 1993. The petition included a statement that missing page 1 was not necessary for an understanding of the subject matter sought to be patented and was accompanied by the \$130 petition fee (37 CFR § 1.17(h)). The petition noted that no claims depended upon missing page 1 for disclosure and

support. The petition was accompanied by a preliminary amendment amending the incomplete sentence starting on page numbered 2 to be a complete sentence and requesting that the pages of the specification be renumbered.

17. On February 20, 1994, the USPTO dismissed the petition under 37 C.F.R. §§ 1.53 and 1.182 because an oath or declaration from the inventors stating their intention to rely on the application without page 1 was not included with the petition.
18. On February 28, 1994, the '985 application was filed in the USPTO under 37 C.F.R. § 1.53. This application contained a two page cover letter stating that 68 pages of specification (including claims, abstract, etc.) and 20 pages of drawings were being filed. The USPTO received the two page cover letter, 20 pages of drawings and 68 pages of specification. The 68 pages of specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The unnumbered title page included the following items in addition to the title: a listing of the 14 inventors by name, a docket number and the name and address of the law firm that prepared the application. Page numbered 2 started in mid-sentence. No filing fees were paid and no oath or declaration accompanied the application. The transmittal sheet accompanying the '985 application indicated that it was a 37 C.F.R. § 1.53 continuation of the '955 application. In addition, on February 28, 1994, the applicants filed a four month extension of time with its fee of \$1,320 in the '955 application. The extension of time included the following fee authorizing language "the Commissioner is authorized to charge any fee or additional amounts due in connection with this communication to Deposit Account No. 04-1073." The extension of time further included in the heading thereof the fact that this extension

was being requested to provide continuity to the 37 C.F.R. § 1.53 (Rule 53) continuation application being filed that day.

19. On March 18, 1994, the USPTO issued a Notice to File Missing Parts – Filing Date Granted in the ‘985 application. The Notice to File Missing Parts required that the filing fees of \$2,156 be paid, the oath or declaration be filed and a \$130 surcharge be paid.
20. On August 29, 1994, the applicants filed a timely response in the ‘985 application. The response included the filing fees, the surcharge, a declaration and a petition under 37 C.F.R. § 1.47 since all the inventors were not able to sign the declaration.
21. On January 19, 1995, the USPTO issued a Notice of Abandonment in the ‘985 application stating that no response was received to the March 18, 1994 Notice to File Missing Parts.
22. On March 23, 1995, the USPTO issued a Notice of Abandonment in the ‘955 application stating that applicant failed to submit the omissions identified in the Notice mailed on February 20, 1994 within the required two months.
23. On September 11, 1995, the applicants filed a petition under 37 C.F.R. § 1.182 requesting the ‘985 application proceed without page 1 and that it be accorded a filing date of February 28, 1994.
24. On September 15, 1995, the USPTO issued a decision granting the petitions under 37 C.F.R. §§ 1.47 and 1.182 in the ‘985 application. In this decision, the USPTO (1) withdrew the January 19, 1995 Notice of Abandonment since a timely response to the March 18, 1994 Notice to File Missing Parts had been filed; and (2) allowed

the '985 application to proceed without page 1 and accorded the '985 application a filing date of February 28, 1994.

25. On April 8, 2003, the '985 application issued as U.S. Patent No. 6,546,399. This patent claimed benefit under 35 U.S.C. § 120 to the '955 application and the '917 application.
26. On November 2, 2007, the applicants filed petitions under 37 C.F.R. §§ 1.53(b) and 1.182 for grant of a filing date of August 31, 1993 in the '955 application and to amend the '955 application to claim priority under 35 U.S.C. § 120 to the '917 application.
27. On August 6, 2008, the USPTO dismissed the petitions in the '955 application that were filed on November 2, 2007.
28. On October 6, 2008, the applicants supplemented the petitions in the '955 application that were filed on November 2, 2007 and requested that the petitions be reconsidered.
29. On March 4, 2009, the USPTO denied the petition in the '955 application that was filed on October 6, 2008.

USPTO Filing Date Practice

30. The USPTO changed its procedures relating to the treatment of prima facie incomplete applications effective July 22, 1996. This change in procedure is set forth in a Notice entitled "Proposed Changes in Procedures Relating to an Application Filing Date" ("Proposed Filing Date Notice"), published in the Federal Register at 60 FR 56982–84 (November 13, 1995) and a Notice entitled "Changes

in Procedure Relating to an Application Filing Date” (“Implemented Filing Date Notice”), published in the Federal Register at 61 FR 30041–46 (June 13, 1996).

Prior to July 22, 1996, the USPTO treated applications filed without all the pages of the specification as prima facie incomplete and did not accord such applications a filing date (“the old missing page procedure”). From July 22, 1996 forward, the USPTO treated applications filed without all the pages of the specification as complete and accorded such applications a filing date (“the new missing page procedure”).

31. I was named as a contact person in both the Proposed Filing Date Notice and the Implemented Filing Date Notice along with my employee Robert W. Bahr. After becoming the Patent Legal Administrator in 1994, I undertook a review of all filing date procedures including the procedure for handling pages omitted from an application filed under 37 CFR § 1.53. From that review, I concluded that there was no requirement in the statutes or regulations that an application filed under 37 CFR § 1.53 include sequentially numbered pages, or all of the pages to obtain a filing date. For example, an application filed under 37 CFR § 1.53 that contained specification pages numbered 1-3 and 5-75, claims numbered 1-10 and ten drawing figures was entitled to a filing date even though specification page 4 was prima facie missing. My conclusion resulted in the publication of both the Proposed Filing Date Notice and the Implemented Filing Date Notice.

32. The old missing page procedure (set forth in Section 608.01 of the MPEP in effect during 1993-1995) was that any application filed under 37 CFR § 1.53 without all the pages of the specification (e.g., with page numbering revealing that page(s) are

missing) was treated as prima facie incomplete and was not accorded a filing date. In such event, the USPTO mailed a Notice of Incomplete Application indicating that a filing date had not been assigned to the application, and would indicate that: (1) the filing date would be the date of receipt of the missing items, and (2) any assertion that the missing item was submitted, or not necessary for a filing date, had to be by way of a petition. To obtain the date of deposit of the application as the filing date, the applicant had to: (1) establish receipt in the USPTO of the allegedly missing item (generally by way of postcard receipt in accordance with MPEP § 503), or (2) petition to have the application accepted as deposited. A petition to have the application accepted as deposited required: (a) an amendment deleting all references to the missing item and correcting the sequential numbering of the pages in the application, (b) a request to cancel the missing item, if such missing item has been submitted after the date of deposit, and (c) a supplemental oath or declaration by the applicant stating that the invention was adequately disclosed in, expressing a wish to rely on the application as thus amended without the missing item and the references thereto in the specification, for purposes of an original disclosure and filing date. The supplemental oath or declaration by the applicant was in effect a statement in writing evidencing that the applicant had been informed of the content of his or her application as filed on the original date of deposit and that the actual content has been reviewed and understood.

33. The Proposed Filing Date Notice (at 60 FR 56983) indicated that (1) a significant number of applicants were willing to accept the application without the missing page, (2) the old missing page procedure resulted in numerous filing date petitions

which were time consuming and burdensome, (3) in most instances there was no controversy as to the content of the prima facie incomplete application (i.e., a grantable petition required only the above-mentioned corrective amendment(s) and supplemental oath or declaration), and (4) there was no requirement in the statutes or regulations that an application filed under 37 CFR § 1.53 include sequentially numbered pages, or all of the pages, or all of the drawings referred to in the specification to obtain a filing date.

34. The Proposed Filing Date Notice (at 60 FR 56984) stated that due to the effect that a loss of filing date can have on an application, the USPTO generally treats untimely filing date petitions on their merits since the application, as incomplete, will have undergone no further processing or examination.

35. The new missing page procedure (set forth in Section 601.01(d)) of the MPEP from July 1996 to the present) is that any application filed under 37 CFR § 1.53 without all the pages of the specification (e.g., with page numbering revealing that page(s) are missing) is treated as prima facie complete and is accorded a filing date. The USPTO continues to review application papers to determine whether all of the pages of the specification are present in the application. If the application is filed without all of the page(s) of the specification, but containing something that can be construed as a written description, at least one drawing figure, if necessary under 35 U.S.C. § 113, the names of all the inventors, and, in a nonprovisional application, at least one claim, the USPTO will mail a “Notice of Omitted Items” indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification. The mailing of a “Notice of Omitted Items” will

permit the applicant to either: (1) promptly establish prior receipt in the USPTO of the page(s) at issue (generally by way of a date-stamped postcard receipt (MPEP § 503)), or (2) promptly submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the page(s) was in fact deposited in the USPTO with the application papers must file a petition under 37 CFR § 1.53(c) (and the petition fee under 37 CFR § 1.17(i), which will be refunded if it is determined that the page(s) was in fact received by the USPTO with the application papers deposited on filing) with evidence of such deposit within two months of the date of the “Notice of Omitted Items.” An applicant desiring to submit the omitted page(s) in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted page(s) with an oath or declaration in compliance with 37 CFR §§ 1.63 and 1.64 referring to such page(s) and a petition under 37 CFR § 1.182 requesting the later filing date within two months of the date of the “Notice of Omitted Items.” An applicant willing to accept the application as deposited in the USPTO need not respond to the “Notice of Omitted Items,” and the failure to file a petition under 37 CFR § 1.53(c) or § 1.182 as discussed above within two months of the date of the “Notice of Omitted Items” will be treated as constructive acceptance by the applicant of the application as deposited in the USPTO. Amendment of the specification is required in a nonprovisional application to renumber the pages consecutively and cancel any incomplete sentences caused by the absence of the omitted pages.

36. The Implemented Filing Date Notice (at 61 FR 30045) stated that the adopted procedure replaces formalistic procedures with procedures based upon the requirements for a filing date as set forth in 35 U.S.C. §§ 111, 112, and 113.

Opinion Regarding Filing Date

37. It is my opinion that that the ‘955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes and regulations in effect at that time. 35 U.S.C. § 111(a)(4) provided that “[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.” 37 CFR § 1.53(b) provided that “[t]he filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75; and (2) any drawing required by 37 CFR § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by 37 CFR § 1.41. The USPTO received 20 pages of drawings and 68 pages of specification including the claims. The 68 pages of specification consisted of an unnumbered title page followed by 67 pages numbered 2-68. The 68 pages of specification contained a description pursuant to 37 CFR § 1.71 and at least one claim pursuant to 37 CFR § 1.75. The 20 pages of drawings contained the drawings required by 37 CFR § 1.81(a). The unnumbered title page set forth the names of the actual inventors as required by 37 CFR § 1.41. As such, all the requirements for a filing date were met by the ‘955 application as deposited in the USPTO on August 31, 1993. Therefore, it is my opinion that that the ‘955

application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes and regulations in effect at that time.

38. At the time the '955 application was filed there was no requirement that the first page of the specification be numbered and it was common for a first page of a document to be unnumbered even when the subsequent pages were numbered. In addition, 37 CFR §§ 1.72(a) and 1.77 together permit the title of the invention to appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application and that such title page may also state the name, citizenship, and residence of the applicant. Since a title page is considered to be part of the specification, it is my opinion that the '955 application as filed on August 31, 1993 was not prima facie incomplete by omitting a page numbered 1. While page numbered 2 started in mid-sentence, this is a minor error correctable by a suitable amendment to that page. Thus, it is my opinion that the '955 application was not "prima facie" incomplete and should not have been subjected to the old missing page procedure set forth in MPEP 608.01. It is my opinion that that the '955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes, regulations and procedures in effect at that time.

39. To the extent that one believes the '955 application filed under 37 C.F.R. § 1.53 was not entitled to a filing date of August 31, 1993 for being incomplete by omitting a page numbered 1 and page numbered 2 starting in mid-sentence, then the old missing page procedure would be in effect. It is my opinion that the petition under 37 C.F.R. §§ 1.53 and 1.182 in the '955 application for a filing date of August 31, 1993 was grantable since the requirements of the old missing page procedure were

complied with. In that regard, the petition under 37 C.F.R. §§ 1.53 and 1.182 included a statement that missing page 1 was not necessary for an understanding of the subject matter sought to be patented and was accompanied by the \$130 petition fee (37 CFR § 1.17(h)) and an amendment canceling from the specification all incomplete sentences and renumbering the pages present in consecutive order. The petition noted that no claims depended upon missing page 1 for disclosure and support. The sole reason the USPTO dismissed the petition under 37 C.F.R. §§ 1.53 and 1.182 was because a declaration from the inventors stating their intention to rely on the application without page 1 was not included with the petition. MPEP 608.01 clearly provides that if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. MPEP 608.01 then proceeds to provide that if the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, **when filed**, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support. Since the applicant in the '955 application had not filed an oath or declaration for the application prior to the date of the petition under 37 C.F.R. §§ 1.53 and 1.182 and the accompanying amendment, it is my opinion that the petition under 37 C.F.R. §§ 1.53 and 1.182 in the '955 application for a filing date of August 31, 1993 should have been granted. In addition to granting a filing date of

August 31, 1993 the petition decision should have set a time period for response for applicant to pay the appropriate filing fees, to file an oath or declaration including a specific reference to the amendment filed October 29, 1993 (i.e., an oath or declaration by the inventors including a statement that their invention is adequately disclosed in, and their wish to rely on, the application as amended on October 29, 1993, without page 1 of the specification for purposes of an original disclosure and filing date) and to pay the surcharge as set forth in 37 C.F.R. § 1.16(e) as provided by 37 C.F.R. § 1.53(d). Thus, it is my opinion that that the ‘955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes, regulations and procedures in effect at that time.

40. It is my opinion that the declaration by the applicants submitted in the ‘985 application in support of the 37 C.F.R. § 1.182 petition in the ‘985 application would be sufficient to correct any deficiency in the 37 C.F.R. §§ 1.53 and 1.182 petition in the ‘955 application that was pointed out by the February 20, 1994 dismissal of that petition. Thus, it could be viewed that the September 15, 1995 grant of the petitions in the ‘985 application, sub silentio, granted relief in the underlying ‘955 application.

Opinion Regarding Fees and Priority

41. It is my opinion that the fee language set forth in the February 28, 1994 extension of time filed in the ‘955 application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l). This extension of time included the following fee authorizing language “the

Commissioner is authorized to charge any fee or additional amounts due in connection with this communication to Deposit Account No. 04-1073.” The extension of time further included in the heading thereof the fact that this extension was being requested to provide continuity to the 37 C.F.R. § 1.53 (Rule 53) continuation application being filed that day. As such, it is clear that a processing and retention fee was due so that continuity under 35 U.S.C. § 120 from the parent application (i.e., the ‘955 application) to the ‘985 continuation application would be appropriate. While 37 CFR § 1.22(b) provided that all patent fees paid to the USPTO **should be** itemized in each individual application in such a manner that it is clear for which purpose the fees are paid, 37 CFR § 1.22(b) does not require such itemization. The practice of the USPTO was to charge any fee required by a paper filed in an application to a Deposit Account if there was a general authorization to do so. The practice of the USPTO did not require an itemization in order to charge a fee to a Deposit Account. For example, a claim amendment requiring additional claim fees would have the needed claim fees charged to a Deposit Account if there was a general authorization to charge any fee due to the Deposit Account. Therefore, it is my opinion that the fee language set forth in the February 28, 1994 extension of time filed in the ‘955 application was sufficient authorization to charge the processing and retention fee as then provided by 37 C.F.R. § 1.21(l).

42. As set forth above, it is my opinion that that the ‘955 application filed under 37 C.F.R. § 1.53 is entitled to a filing date of August 31, 1993 under the statutes, regulations and procedures in effect at that time. It is my further opinion that a time period for applicant to pay the appropriate filing fees, to file an appropriate oath or

declaration and to pay the surcharge as set forth in 37 C.F.R. § 1.16(e) as provided by 37 C.F.R. § 1.53(d) has never been set in the '955 application. In that regard, as noted earlier, the September 14, 1993 Notice to File Missing Parts – No Filing Date did not set a specific time period for paying the appropriate filing fees, filing an appropriate oath or declaration and to pay the surcharge as set forth in 37 C.F.R. § 1.16(e). The missing parts practice when a filing date petition was granted was to either (1) set an extendible period for response to file the missing parts and surcharge in the granted filing date decision, or (2) to return the file to Application Branch for the mailing of a Notice to File Missing Parts of Application - Filing Date Granted, setting an extendible period for filing the missing parts and surcharge. Accordingly, it is my opinion that the '955 application is still pending.

43. Since the '955 application is still pending with a filing date of August 31, 1993 for the reasons set forth above, it is possible for applicant to timely pay the basic filing fee due in this application and to amend the specification to contain a specific reference to the earlier filed '917 application which can be relied upon for priority as provided by 35 U.S.C. § 120 and 37 CFR § 1.78(a). In addition, since the '955 application is pending it can be relied upon for priority as provided by 35 U.S.C. § 120 and 37 CFR § 1.78(a) in the '985 application.

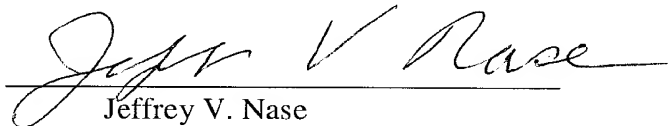
Summary of Opinion Formed

44. For the reasons set forth above, it is my opinion that Application No. 08/113,955 is entitled to a filing date of August 31, 1993 and the '955 application can be relied

upon for priority under 35 U.S.C. § 120 and 37 CFR § 1.78(a) from the '985 application to the '917 application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

May 4, 2009
Date



Jeffrey V. Nase